

### **III. Remarks**

By this paper, Applicant is amending claims 8, 13, and 16; and cancelling claim 14. Therefore, after entering this amendment, claims 1-13 and 15-19 are currently pending.

Reconsideration and further examination of this application in view of the above amendments and the following remarks is therefore respectfully requested.

#### ***Specification***

Paragraph [0038] has been amended to recite that a *film* is positioned within the mold 10 such as to be aligned with the first portion 28 of the mold inner surface 18. Support for this amendment may be found in Paragraph [0038] in the original Application as filed. For example, Paragraph [0038] states that Step 56 in this process 32d is to remove the dried chlorinated polyolefin film from the sheet and insert the film within the mold 10. Therefore, no new matter is added.

#### ***Claim Clarifications***

Claim 13 has been amended to depend from claim 12, thereby clarifying and more particularly pointing and distinctly claiming that which Applicant regards as the subject matter of the present invention.

#### ***Claim Rejections – 35 U.S.C. § 102***

The Examiner rejected claims 8, 16, and 17 under 35 U.S.C. § 102(b) as being anticipated by *Ladney, Jr.* (U.S. Patent No. 3,871,060).

Claim 8 has been amended to recite the steps of providing a substance, applying an electrical charge to a plurality of particles of the substance, electrically grounding at least a portion of the mold, and applying the substance to the inner surface of the mold.

*Ladney, Jr.* fails to disclose each and every element of amended claim 8. For example, *Ladney, Jr.* fails to disclose the steps of applying an electrical charge to a plurality of particles of the substance and electrically grounding at least a portion of the mold. Rather, the method disclosed in *Ladney, Jr.* is to apply a layer of paint to a foam molding surface by spraying the paint directly onto the mold, without the step

of applying an electrical charge to the paint. (*Ladney, Jr.*, col. 4, lines 50-63). Therefore, the paint from the method disclosed in *Ladney, Jr.* is not electrically attracted to the mold. Therefore, *Ladney, Jr.* fails to disclose each and every element of amended claim 8 and the Examiner's rejection of claim 8 should be withdrawn.

Claims 9-13 and 15 depend from claim 8. Therefore, for the reasons discussed above, the Examiner's rejection of claims 8-13 and 15 should be withdrawn.

Claim 16 has been amended to recite the steps applying an electrical charge to a plurality of particles of a substance, electrically grounding at least a portion of the mold, and spraying the plurality of particles of the substance onto the inner surface of the mold.

As discussed above with respect to claim 8, *Ladney, Jr.* fails to disclose each and every element of amended claim 16. For example, *Ladney, Jr.* fails to disclose the steps of applying an electrical charge to a plurality of particles of the substance and electrically grounding at least a portion of the mold. Rather, the method disclosed in *Ladney, Jr.* is to apply a layer of paint to a foam molding surface by spraying the paint directly onto the mold, without the step of applying an electrical charge to the paint. (*Ladney, Jr.*, col. 4, lines 50-63). Therefore, the paint from the method disclosed in *Ladney, Jr.* is not electrically attracted to the mold. Therefore, *Ladney, Jr.* fails to disclose each and every element of amended claim 16 and the Examiner's rejection of claim 16 should be withdrawn.

Claims 17-19 depend from claim 16. Therefore, for the reasons discussed above, the Examiner's rejection of claims 16-19 should be withdrawn.

#### ***Claim Rejections – 35 U.S.C. § 103***

The Examiner rejected claims 1, 2, 5, 9-11, and 15 under 35 U.S.C. § 103(a) as being unpatentable over *Ladney, Jr.* in view of *Nakajima* (U.S. Patent No. 4,608,415).

As stated by the Examiner, *Ladney, Jr.* does not teach the use of a chlorinated polyolefin and therefore claim 1 is not anticipated by *Ladney, Jr.*

Furthermore, the deficiencies of *Ladney, Jr.* are not cured by combination with *Nakajima*.

For example, *Ladney, Jr.* and *Nakajima* are not properly combinable with each other because they are nonanalogous references and they are not concerned with the same problem. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." (MPEP § 2141.01(a)). *Ladney, Jr.* discloses a mold for forming foamed plastic parts whereas *Nakajima* discloses a coating material containing a modified chlorinated resin. *Ladney, Jr.* fails to disclose a chlorinated resin, or any other similar compounds discussed in *Nakajima*, and *Nakajima* fails to disclose any molding or coating techniques or methods such as those discussed in *Ladney, Jr.*

Furthermore, the two references are not reasonably pertinent to the same problem because the mold for forming plastic foam parts in *Ladney, Jr.* is designed to provide a mold with a longer operational life than those previously known in the art and the *Nakajima* is designed to provide a coating material that improves weather resistance, adhesion, stability, and other advantageous coating properties. The Examiner states that it would have been obvious to one of ordinary skill in the art at the time the invention was made to use chlorinated polyolefins as a base paint coating material because of the known advantages that chlorinated polyolefins provide. However, *Ladney, Jr.* fails to disclose or suggest any advantages of coating an object with chlorinated polyolefins or any other coatings and *Nakajima* fails to disclose any advantages of molding an article or any other means for forming an article. Therefore, the deficiencies of *Ladney, Jr.* are not cured by combination with *Nakajima* and the Examiner's rejection of claim 1 should be withdrawn.

Claims 2 and 5 depend from claim 1. Therefore, for the reasons discussed above, the Examiner's rejection of claims 1, 2, and 5 should be withdrawn.

Claims 9-11 and 15 depend from claim 8. Therefore, claims 9-11 and 15 are not anticipated by *Ladney, Jr.* for the reasons discussed above. Furthermore, the deficiencies of *Ladney, Jr.* are not cured by combination with *Nakajima*.

For example, even if the references are properly combinable, *Nakajima* fails to disclose the steps of applying an electrical charge to a plurality of particles of the substance and electrically grounding at least a portion of a mold. Rather, the *Nakajima* fails to disclose a mold for forming an article and fails to disclose the step of applying an electrical charge to a plurality of particles. Rather, *Nakajima* discloses a coating material containing a modified chlorinated resin but does not disclose any techniques or methods for applying the coating material onto objects such as molds or molded articles. (*Nakajima*, Abstract). Therefore, the deficiencies of *Ladney, Jr.* are not cured by combination with *Nakajima* and the Examiner's rejection of claims 9-11 and 15 should be withdrawn.

Additionally, *Ladney, Jr.* and *Nakajima* are not properly combinable with each other because they are nonanalogous references and they are not concerned with the same problem. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." (MPEP § 2141.01(a)). *Ladney, Jr.* discloses a mold for forming foamed plastic parts whereas *Nakajima* discloses a coating material containing a modified chlorinated resin. *Ladney, Jr.* fails to disclose a chlorinated resin, or any other similar compounds discussed in *Nakajima*, and *Nakajima* fails to disclose any molding or coating techniques or methods such as those discussed in *Ladney, Jr.* Furthermore, the two references are not reasonably pertinent to the same problem because the mold for forming plastic foam parts in *Ladney, Jr.* is designed to provide a mold with a longer operational life than those previously known in the art and the *Nakajima* is designed to provide a coating material that improves weather resistance, adhesion, stability, and other advantageous coating properties. Therefore, the deficiencies of *Ladney, Jr.* are not cured by combination with *Nakajima* and the Examiner's rejection of claims 9-11 and 15 should be withdrawn.

The Examiner rejected claims 3, 4, 6, 7, 12-14, 18, and 19 under 35 U.S.C. § 103(a) as being unpatentable over *Ladney, Jr.* and *Nakajima* in view of *Rechenberg* (U.S. Publication No. 2004/0249075).

Claims 3, 4, 6, and 7 each depend from claim 1. Therefore, claims 1, 3, 4, 6, and 7 are not anticipated by *Ladney, Jr.* for the reasons discussed above. Additionally, as stated by the Examiner, *Ladney, Jr.* in view of *Nakajima* do not teach electrostatic spraying of the coatings. Furthermore, the deficiencies of *Ladney, Jr.* are not cured by combination with *Nakajima* because *Ladney, Jr.* and *Nakajima* are not properly combinable as discussed above. Moreover, the deficiencies of *Ladney, Jr.* and *Nakajima* are not cured by combination with *Rechenberg*.

For example, even if *Rechenberg* is properly combinable with *Ladney, Jr.* and *Nakajima*, the combination fails to disclose the steps of applying an electrical charge to a plurality of particles of the substance and electrically grounding at least a portion of a mold. Rather, *Rechenberg* fails to disclose the step of electrically grounding at least a portion of the mold and applying the substance to the inner surface of the mold and neither of the other references discloses the step of electrically charging any particles or electrically grounding any components. *Rechenberg* discloses applying an electrostatic charge to a thermostat composition, electrically grounding the substrate that is to be coated, and depositing the particles directly onto the substrate. (*Rechenberg*, Paragraph [0092]). Therefore, even if the three references are properly combinable, the deficiencies of *Ladney, Jr.* and *Nakajima* are not cured by combination with *Rechenberg* and the Examiner's rejection of claims 3, 4, 6, and 7 should be withdrawn.

Additionally, it would not be obvious to modify *Rechenberg* to include a method of electrostatic spray for applying electrical charge to particles, electrically grounding the mold, and applying the particles to the mold. More specifically, such a modification fails to establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine the reference teachings. (MPEP § 2142). Neither *Ladney, Jr.* nor *Nakajima* contains a suggestion or motivation to modify *Rechenberg* to apply electrically ground a mold and apply a substance to the mold rather than to electrically ground a substrate and deposit the particles directly onto the substrate.

Additionally, such a modification fails to establish a *prima facie* case of obviousness because *Rechenberg* teaches away from the claimed invention. For

example, *Rechenberg* explicitly states that the electrostatic application process is not used when the substrate is not electrically conductive. More specifically, *Rechenberg* states, "Alternatively, when the substrate is not electrically conductive, for example as is the case with many plastic substrates, the substrate is typically preheated prior to application of the thermosetting composition." (*Rechenberg*, Paragraph [0093]). Because there is no suggestion or motivation to modify *Rechenberg* to apply electrically ground a mold and apply a substance to the mold, the rejection of claims 3, 4, 6, and 7 should be withdrawn.

Claims 12-13 depend from claim 8, claims 18-19 depend from claim 16, and claim 14 has been cancelled. Therefore, claims 12-13 and 18-19 are not anticipated by *Ladney, Jr.* for the reasons discussed above. Additionally, as stated by the Examiner, *Ladney, Jr.* in view of *Nakajima* do not teach electrostatic spraying of the coatings. Furthermore, the deficiencies of *Ladney, Jr.* and *Nakajima* are not cured by combination with *Rechenberg*.

For example, even if the references are properly combinable, *Rechenberg* fails to disclose the steps of applying an electrical charge to a plurality of particles of the substance and electrically grounding at least a portion of a mold. Rather, the *Rechenberg* fails to disclose the step of electrically grounding at least a portion of the mold and applying the substance to the inner surface of the mold. For example, *Rechenberg* discloses applying an electrostatic charge to a thermostat composition, electrically grounding the substrate that is to be coated, and depositing the particles directly onto the substrate. (*Rechenberg*, Paragraph [0092]). Therefore, the deficiencies of *Ladney, Jr.* and *Nakajima* are not cured by combination with *Rechenberg* and the Examiner's rejection of claims 12-13 and 18-19 should be withdrawn.

Additionally, it would not be obvious to modify *Rechenberg* to include a method of electrostatic spray for applying electrical charge to particles, electrically grounding the mold, and applying the particles to the mold. More specifically, such a modification fails to establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine the reference

teachings. (MPEP § 2142). Neither *Ladney, Jr.* nor *Nakajima* contains a suggestion or motivation to modify *Rechenberg* to apply electrically ground a mold and apply a substance to the mold rather than to electrically ground a substrate and deposit the particles directly onto the substrate.

Additionally, such a modification fails to establish a *prima facie* case of obviousness because *Rechenberg* teaches away from the claimed invention. For example, *Rechenberg* explicitly states that the electrostatic application process is not used when the substrate is not electrically conductive. More specifically, *Rechenberg* states, "Alternatively, when the substrate is not electrically conductive, for example as is the case with many plastic substrates, the substrate is typically preheated prior to application of the thermosetting composition." (*Rechenberg*, Paragraph [0093]). Because there is no suggestion or motivation to modify *Rechenberg* to apply electrically ground a mold and apply a substance to the mold, the Examiner's rejection of claims 12-13 and 18-19 should be withdrawn.

### ***Conclusion***

In view of the above amendments and remarks, it is respectfully submitted that the present form of the claims are patentably distinguishable over the art of record and that this application is now in condition for allowance. The Examiner is invited to contact the undersigned attorney for the Applicants via telephone number (312) 245-5390, if such communication would expedite this application.

Respectfully submitted,



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April 17, 2007  
Date